

REMARKS

I. Introduction

Upon entry of the present amendment, claims 1-6, 8-17, 20-35, 40-46 and 51-52 will be pending in the present application. By the present amendment, claims 1, 8-12, 32-35 and 41-44 have been amended, and claims 7, 18-19, 36-39, and 47-50 have been cancelled. Support for the present amendments can be found in the specification at, *inter alia*, original claim 7. No new matter has been added herein by the present amendment.

In view of the foregoing amendments and the following remarks, Applicant respectfully submits that the claims are now in condition for allowance. Applicant points out that the amendments made herein are made without prejudice to the future prosecution of such cancelled, amended or modified subject matter in a related divisional, continuation or continuation-in-part application.

II. Rejection of Claims Under 35 U.S.C. § 103

Claims 1-39 and 41-52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,607,806 (“Kanbayashi et al.”) in combination with U.S. Patent No. 5,874,019 (“Uchida et al.”). Applicant respectfully submits that these rejections should be withdrawn for at least the following reasons.

Independent claim 1 has been amended herein to include the recitations of previously pending claim 7. Specifically, claim 1 now recites that “the post-blended particulate additive further comprises a tribo-charging additive which, upon tribo-charging of the toner particulates, shifts the charge distribution in either the positive or negative direction as compared with the charge distribution in the absence of the additive.” Claims 2-6, 8-17,

20-35, 41-46 and 51-52 all ultimately depend from claim 1, and thus include this claim limitation as well.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, the prior art references, when combined, must teach or suggest all the claim limitations, there must be some reason to combine or modify the reference teachings, with a reasonable expectation of success. MPEP § 2143. Applicant respectfully submits that a *prima facie* case of obviousness has not been established by the cited references.

First of all, Applicant respectfully submits that one of ordinary skill in the art would have no reason to turn to the teachings of Uchida et al. after having read the disclosure of Kanbayashi et al. Specifically, Kanbayashi et al. details the disadvantages perceived to be present in the addition of charge control agents as *post-additives*. (See Kanbayashi et al., column 2, lines 12-55). Thus, there would be no incentive or motivation for one of ordinary skill in the art to experiment with and develop such post-blending additives.

However, assuming arguendo that one of ordinary skill in the art did combine the teachings of Kanbayashi et al. and Uchida et al., one would still not arrive at the presently claimed invention.

Kanbayashi et al. is directed to a toner with organically treated alumina for developing electrostatic image. Kanbayashi et al. proceeds from the assumption that good fluidization of the toner particles that are used to develop electrostatic images will provide for good image (*i.e.*, print) quality. Kanbayashi et al. employs alumina powder as a fluidizing additive. More specifically, according to Kanbayashi et al., the alumina powder: (i) is

organically treated; (ii) has a X-ray diffraction characteristic showing a maximum X-ray intensity level $I_{\alpha\text{-max}}$ and a minimum X-ray intensity level $I_{\alpha\text{-min}}$ in a 2θ range of 20 to 70 degrees providing a ratio of $I_{\alpha\text{-max}} / I_{\alpha\text{-min}}$ of below 6 (*see* Kanbayashi et al., column 4, lines 32-40); and (iii) also comprises a substantial amount of structural water (*see* Kanbayashi et al., column 6, lines 55-64). In addition, although the Examiner has stated that Kanbayashi et al. discloses the use of silica as an additive, Applicant respectfully disagrees. In column 7, lines 27 to 30 of Kanbayashi et al., the use of the alumina described therein is simply contrasted with the use of silica fine particles. To that end, it is instructive to note that none of the Examples of Kanbayashi et al. describe a toner composition having a silica additive.

In all of the examples of Kanbayashi et al., the toner incorporates a separate charge controlling additive. Therefore, it is clear that the toner generates its own electrostatic charge, which may be negative or positive depending on the actual charge controlling additive employed. The alumina only has utility when the toner particle is capable of generating its own charge and then acts only to discharge already charged toner particles (*see* Kanbayashi et al., column 10, lines 42-46). The presence of the structural water enhances the discharging behavior of the alumina. That is, the alumina dampens down excessive charge generation on the toner in low humidity environments where there is little or no airborne moisture to perform discharge.

In contrast to the teachings of Kanbayashi et al., the present invention provides an additive that has functionality with respect to the toner particles irrespective of whether that particle comprises a charge control agent. In accordance with the present invention as currently recited in claim 1, the post-blended particulate additive can impart a stabilized positive or negative charge, either high or low, to those particles. That is, the additive can

enhance and increase the triboelectric charging of the powder, rather than simply discharging the present charges.

Uchida et al. does not cure the shortcomings of Kanbayashi et al. Neither column 11, lines 10 to 35 of Uchida et al. (as referenced in the Office Action) nor the Examples contained therein, teach or suggest the use of a three-component post-blended additive as currently recited in claim 1.

Therefore, none of the cited references, alone or in combination, teach or suggest the presently claimed toner composition as currently recited in independent claim 1.

For at least the preceding reasons, it is respectfully submitted that the rejections under 35 U.S.C. §103(a) have been overcome and should therefore be withdrawn.

III. Conclusion

In view of the preceding amendment and remarks, it is respectfully submitted that the application is in condition for allowance and prompt consideration is respectfully requested.

Respectfully submitted,
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